

REMARKS

Claim 16 is added, and therefore claims 7 and 9 to 16 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 7 and 9 to 15 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0054229 ("Odaohhara").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 7 has been rewritten to better clarify the claimed subject matter.

Claim 7, as presented, includes the feature of *adapting continuously a parameter of a mathematical model of the energy storage mechanism to a real value over the lifetime of the energy storage mechanism; performing extrapolation via the mathematical model; determining at regular intervals the remaining lifetime based on the extrapolation, in which the parameter of the mathematical model is adapted between the regular intervals, and in which the remaining lifetime is defined as a time until reaching any definable limiting values*

for one of a minimum efficiency and a minimum storage capacity; indicating the remaining lifetime; and when a level falls below a preselectable threshold for the remaining lifetime, providing a warning.

The “Odaohhara” reference does not identically disclose (nor suggest) the feature of *adapting continuously a parameter of a mathematical model of the energy storage mechanism to a real value over the lifetime of the energy storage mechanism*, as provided for in the context of the presently claimed subject matter. In particular, no parameters of the model of an estimated minimum capacity, nor any parameters from any other models referred to by the “Odaohhara” reference, are adapted to a real value over the lifetime of an energy storage mechanism.

Also, the “Odaohhara” reference does not identically disclose (nor suggest) the feature of *performing extrapolation via a mathematical model*, as provided for in the context of the presently claimed subject matter. In particular, the model of an estimated minimum capacity is not extrapolated, nor is any other model referred to by the “Odaohhara” reference.

Also, the “Odaohhara” reference does not identically disclose (nor suggest) the features of *determining at regular intervals the remaining lifetime based on the extrapolation, in which the parameter of the mathematical model is adapted between the regular intervals, and in which the remaining lifetime is defined as a time until reaching any definable limiting values for one of a minimum efficiency and a minimum storage capacity; indicating the remaining lifetime; and when a level falls below a preselectable threshold for the remaining lifetime, providing a warning.* The reference to determining whether the service life of a battery expires referred to by the “Odaohhara” reference simply does not identically disclose (nor suggest) the feature of *determining a remaining lifetime*. As understood, the service life of a battery referred to by the “Odaohhara” reference corresponds to the guarantee period of the battery -- and not the remaining lifetime. Even looking beyond the service life of a battery referred to by the “Odaohhara” reference, the “Odaohhara” reference does not in any way refer to *determining a remaining lifetime*.

Accordingly, claim 7, as presented, is allowable, as are any of its dependent claims. Claim 12, as presented, includes features like those of claim 7, as presented, and is therefore allowable for essentially the same reasons, as is its dependent claim 15.

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Odaohhara” reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As further regards the obviousness rejection, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. (*See also* MPEP § 2144.03).

Claim 13 depends from claim 7, as presented, and is therefore allowable for essentially the same reasons as claim 7, since any purported teachings in the art do not overcome — and are not asserted to overcome — the critical shortcomings of the “Odaohhara” references as to claim 7, as presented. Withdrawal of the obviousness rejection of claim 13 is therefore respectfully requested.

New claim 16 does not add new matter and is supported by the present application, including the specification. Claim 16 depends from claim 7, and it is therefore allowable for the same reasons. Additionally, it includes further features, the combination of which is neither disclosed nor suggested by the applied references, including for the reasons explained above.

In summary, all of pending claims 7 and 9 to 16 are allowable.

CONCLUSION

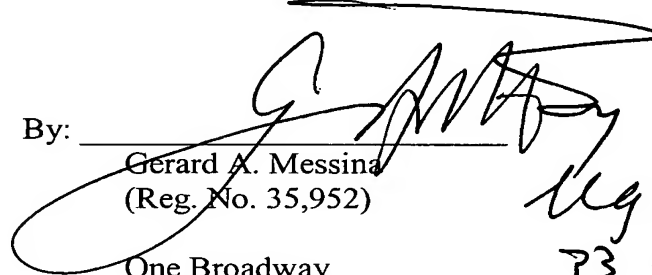
In view of the foregoing, it is respectfully submitted that all pending claims 7 and 9 to 16 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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